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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

2657.2001-005

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on 05-17-06

Signature Donna Bartolone

Typed or printed name Donna Bartolone

Application Number

09/519,221

Filed

March 6, 2000

First Named Inventor

Chaitanya Kanojia

Art Unit

2143

Examiner

George C. Neurauter

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

attorney or agent of record.

Registration number 51,425

Michael J. Badzinski  
Signature

Michael J. Badzinski

Typed or printed name

978-341-0036

Telephone number

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34       

5/17/06

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below\*.

\*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Chaitanya Kanojia, Lee Kamentsky and Peter Hall

Application No.: 09/519,221 Group: 2143

Filed: March 6, 2000 Examiner: George C. Neurauter

Confirmation No.: 7967

For: SYSTEM AND METHOD FOR PROVIDING GUARANTEED DELIVERY OF  
MESSAGES TO EMBEDDED DEVICES OVER A DATA NETWORK  
(AS AMENDED)

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REMARKS TO ACCOMPANY PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

These remarks are being filed with an accompanying Pre-appeal Brief Request for Review in response to the Office Action mailed from the U.S. Patent and Trademark Office on November 17, 2005 in the above-identified application. Please consider these remarks in the requested Pre-appeal Brief Review.

**REMARKS**

The following remarks are being submitted with a Notice of Appeal under 37 C.F.R. § 41.31 and in support of a Pre-Appeal Brief Request for Review in the above-identified application.

In the subject application, a Final Office Action dated November 17, 2005 finally rejected claims 2-6, 9-13 and 15-16 under 35 U.S.C. § 102 as being anticipated by “NewNet SMserver: Wireless Short Message Service Tutorial” hereinafter “NewNet” and claims 7 and 14 were rejected under 35 U.S.C. § 103 as being unpatentable over NewNet.

The Applicants believe these rejections of record are clearly not proper and without basis. In support of this position, the below presents clear legal and/or factual deficiencies in these rejections.

As argued in the Applicants’ response filed February 22, 2005, the Applicants respectfully maintain that NewNet does not implicitly or explicitly disclose the Applicants’ claimed combination of *a unique identifier that is independent of any communication protocol and transmitting a message to a destination address associated with an embedded device regardless of whether the embedded device is active on the data network*.

In the Examiner’s Advisory Action mailed on April 6, 2006, the Examiner seems to claim that NewNet discloses a universal messaging environment and that in order for the Short Message Service (SMS) system to operate in this environment, there must be some sort of unique identifier that is used by the SMS system to deliver messages along heterogeneous networks that make up this environment. Therefore, the Examiner concludes, “NewNet” inherently discloses a unique identifier that is protocol independent. The Applicants respectfully disagree.

The Examiner seems to fail to take into consideration multiple levels of communication protocols that are typically used to transport information (e.g., messages) through a heterogeneous network. These levels may include lower-level communication protocols, such as protocols as the hardware and data link layers, that are typically used to transport information point-to-point between nodes in the network and higher-level communication protocols, such as protocols at the network layer and above, that are typically used to transport the information between end points in the network. These endpoints may include a source from which the information originates and a destination where the information is to be delivered.

Many intermediate nodes may lie in a path used to convey the information between the source and destination. Here, the intermediate nodes may use the lower-level as well as higher-level communication protocols to forward the information hop-by-hop along the path through the network. Specifically, the higher-level communication protocols may be used to identify a next hop in the path. The lower-level communication protocols may be used to physically transport the information to the identified next hop.

A unique identifier, as suggested by the Examiner, may be used by higher-level communication protocols to convey information on a path through a network to its destination. Specifically, the higher-level protocols may use the unique identifier to identify e.g., a port through which a next hop on the path may be reached. Thus, the identifier is protocol dependent and is not independent of any communication protocol because it is used by the higher-level communication protocols to determine how to route information to its destination.

For example, assume a user at a computer coupled to the Internet generates a message for delivery to a mobile telephone in an SMS network. Further, assume the message contains an identifier of the mobile telephone in the form of an e-mail address that contains the phone number assigned to the mobile telephone and the domain name of the mobile telephone's service provider (SP). A typical scenario for transporting the message to the mobile telephone is as follows. The message travels from the user's computer to the user's Internet Service Provider (ISP). The ISP forwards the message onto the Internet to a short message service center (SMSC) at the mobile telephone's SP. As the message travels through the Internet it is being transported hop-by-hop to the SP's gateway. Lower-level protocols, such as Asynchronous Transfer Mode (ATM) and Ethernet, may be used to physically transport the message between hops. At a higher layer, the message is routed to the SMSC using the SP's domain name contained in the identifier. After the SMSC receives the message, it examines the e-mail address, uses the telephone number contained therein to identify the mobile telephone that is to receive the message and forwards the message to the SP's SMS-Gateway/Internetworking Mobile Switching Center (SMS-GMSC). The SMS-GMSC then routes the message to the Mobile Switching Center (MSC) to which the mobile telephone is registered (i.e., the MSC serving the mobile telephone). The MSC receives the message and transfers it to the mobile telephone. Note that the identifier is used by higher-level communication protocols to forward the message from the user along a path through the

network to the mobile telephone. Thus, the identifier is not independent of any communication protocol and is different than the Applicants' claimed unique identifier which is independent of any communication protocol.

Regarding the Applicants' claimed *transmitting a message to a destination address associated with an embedded device regardless of whether the embedded device is active on the data network*, the Examiner argues that NewNet discloses this on page 6, in section 4.2 "Subscriber Services". The Applicants respectfully disagree.

The section quoted by the Examiner merely mentions that for messages that do not require immediate delivery, one or more delivery attempts may be made to transport the messages to a mobile station to which the messages are addressed. This as opposed to messages which require immediate delivery which as NewNet teaches only one delivery attempt is made per service request. Nowhere does NewNet indicate that the delivery attempts are made regardless of whether the mobile station is active (registered) on the network. In fact, NewNet seems to suggest that a mobile station must be active in the network before an attempt is made to transfer a message to the mobile station.

Specifically, on page 6 in section 4 "Signaling Elements", NewNet states that "before attempting short message delivery, the SMSC needs to determine the servicing MSC for the mobile station at the time of the delivery attempt." Further, NewNet states that with respect to point-to-point short message delivery from an SMSC to an MSC, "the mechanism provides a means for the SMSC to transfer a short message to the MSC which is serving the addressed mobile station and attempts to deliver a message to an MS whenever the MS is registered." These statements seem to indicate that a mobile station (MS) needs to be active (registered) with an MSC before an attempt is made to deliver the message to the mobile station. This makes sense because in NewNet a mobile station needs to be registered with an MSC in order for the SMSC to identify which MSC to route the message to in order to reach the mobile station. Further, when a mobile station registers with an MSC, the mobile station makes the MSC aware that it is active and capable of receiving the messages. Thus, when the MSC receives a message for the mobile station, the MSC can freely forward the message to the mobile station knowing that the mobile station is active and capable of receiving the message.

Lastly, in the advisory action, the Examiner states that "absent of any requirement or explanation within the claims as to how the message can be received by a device and an acknowledgement sent to the router when the device is not active on the network which includes the interpretation wherein the device is offline and disconnected from the network, the claims are not in condition for allowance." The Examiner appears to be reading limitations in the claims that are not present.

The Applicants respectfully point out that the claims do not require that acknowledgements be sent to the router from the embedded devices. Rather, the claims recite that the router waits for acknowledgement of the messages from the embedded devices and stores unacknowledged messages in a message store until corresponding embedded devices can accept the unacknowledged messages. Nowhere do the claims require that acknowledgements be sent to the router from the embedded devices.

### CONCLUSION

According to the forgoing, it is respectfully requested that the panel find: (i) that all existing claims are in condition for allowance and that the application should pass to issue, or in the alternative, (ii) that prosecution on the merits of the case should be reopened with an appropriate Office communication.

If a telephone conference would expedite prosecution of this case, the undersigned may be reached at (978) 341-0036.

Respectfully submitted,

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.

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